REMARKS

The Office Action dated June 6, 2006, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-19, 21-40, and 42-52 are currently pending in the application, of which claims 1, 19, 32, 40, and 51-52 are independent claims. Claims 1, 3, 9, 17, 19, 22, 30, 32-36, 38-40, and 42-48 have been amended, and claims 51-52 have been added, to more particularly point and distinctly claim the invention. No new matter has been added. Claims 1-19, 21-40, and 42-52 are respectfully submitted for consideration.

Claims 1-19, 21-40, and 42-50 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Office Action took the position that the claims recite "data structure" not claimed as embodied on a computer-readable media. Additionally, the Office Action took the position that the invention has "no practical application in the technological arts."

With regard to practical application, certain embodiments of the present invention, as explained at page 1, lines 10-15 of the specification, are useful in low bandwidth networks.

The Office Action proposed "executable" phraseology. Claims 1, 3, 9, 17, 19, 22, 30, 32-36, 38-40, and 42-48 have been amended, and it is respectfully submitted that the

amendment to claims 1, 3, 9, 17, 19, 22, 30, 32-36, 38-40, and 42-48 renders that portion of the rejection moot.

Claims 1-19, 21-40, and 42-50 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. The Office Action presented various objections to the claims. With regard to claims 1, 3, 17, 22, 30, and 32 it respectfully submitted that the amendments render the rejection moot.

With regard to the remainder of the claims, Applicants respectfully submit that the claims are definite without further amendment. For example, there is no requirement that specific examples of encoding or compression be provided, as the Office Action implicitly asserted. Likewise, although information cannot be decompressed unless it is first compressed, there is no requirement that the claimed method in claim 18 include the compression of the information.

Claims 1-2, 14-15, 19, 21, 27-28, and 32-50 were again rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,864,860 of Holmes ("Holmes") in view of U.S. Patent No. 6,028,962 of Claassen et al. ("Claassen"). The Office Action took the position that Holmes teaches all of the elements of the claims except "determine a type of classification based on said comparing and using the determined type to control how the information is communicated." The Office Action cited Claassen as teaching this limitation. Applicants respectfully traverse this rejection.

Claim 1, upon which claims 2-18 depend, is directed to a method including communicating information. The method also includes comparing a current item list containing a plurality of current items with a reference item list containing a plurality of reference items. The method further includes determining a type of classification based on the comparing of the items of the lists. The method additionally includes using the determined type of classification to control the communicating the information.

Claim 19, upon which claims 21-31 depend, is directed to a method including classifying at least one item of a current list containing a plurality of items by comparing the current list with a reference list containing a plurality of items. The method also includes, based upon the classifying of the at least one item of the current list, forming a compressed list including the at least one item. The method further includes transmitting the compressed list. The method additionally includes determining a type of classification based on the comparing.

Claim 32, upon which claims 33-39 depend, is directed to a device including a processor configured to compare a current item list containing a plurality of current items with a reference item list containing a plurality of reference items, to determine a type of classification based on the comparing of the items of the lists, and to communicate compressed information based upon the determined type of classification.

Claim 40, upon which claims 42-50 depend, is directed to a device including a processor configured to classify at least one item of a current list containing a plurality of items by comparing the current list with a reference list containing a plurality of items

and based upon the classifying of the at least one item of the current list to form a compressed list including the at least one item. The device also includes a transmitter configured to transmit the compressed list. The processor is configured to determine a type of classification based on the comparing.

Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the cited combination of Holmes and Claassen.

Holmes relates to compression of structured data. Specifically, as explained in columns 3-4, Holmes relates to data compression in the area of delimited text databases. For example, each row (or record) of data will contain a set of fields delimited from each other by a character. Holmes discloses comparing a field of a current record with a corresponding field of a previous record. Holmes suggests creating a compressed form of the current record based on the current row. The compressed form of the current record is the same as the current record except that, if the contents of a field of the current record are identical to that of the corresponding field in the previous record, a single character (such as a ".") is used in place of the contents. When all of the fields have been compared and (if appropriate) compressed, the compressed form of the current record is passed to the client.

As The Office Action recognized, Holmes fails to disclose or suggest all of the elements of any of the presently pending claims. The Office Action supplied Claassen to remedy the deficiencies of Holmes.

Claassen is directed to a system and method for variable encoding based on image content. Claassen aims to compress images that may contain portions with dissimilar image content, such as bi-level text, graphics, half-tone images, and multi-level image data. Claassen also aims to classify windows and code the windows based on the classification. All of Claassen is directed toward image compression techniques. Nothing in Claassen suggests or hints at applications beyond image compression. Accordingly, Claassen naturally does not disclose or suggest to "determine a type of classification based on said comparing and using the determined type to control how the information is communicated," as the Office Action admitted.

The Office Action suggested that the combination of Claassen and Holmes renders the above-identified claims obvious. Applicants respectfully submit that the combination of references is improper. Claassen and Holmes are from different fields of compression. Claassen seeks to compress image data, while Holmes compresses structured data in a data sequence having a plurality of records.

The Office Action took the position that it would have been obvious to combine Claassen with Holmes to efficiently improve the effect of the compression, thereby enabling a reduction in the amount of data to be transferred. However, there is no obvious way to combine the graphic compression techniques described in Claassen with the structured data compression scheme of Holmes. The two references provide different, incompatible techniques for compression designed to work in the two separate fields of compression in which the two references respectively were located.

Motivation to combine can come from the references themselves, from the nature of the problem, or from the knowledge of one of ordinary skill in the art. With regard to Holmes' and Claassen's disclosures, there is nothing in the references that would motivate the combination of the graphics compression technique and the structured data compression technique. The Office Action's suggestion that the combination would reduce the amount of data to be transferred falls flat. Neither reference suggests that modifying Holmes' system with Claassen's system would reduce the amount of data transferred. Piling compression schemes on top of one another does not necessarily reduce the amount of data transferred and may, in some instances, increase the amount of data transferred.

Finally, as Holmes' system is character-based (col. 2, ll. 53-58) and Claassen's system is graphical (col. 4, ll. 10-16), the two systems are incompatible, and therefore could not be readily combined. For this and the other reasons explained above, it is respectfully submitted that there is no motivation to combine the references, that the combination of the teachings of the references would not have been considered to be feasible by one of ordinary skill in the art, and that the references are in non-analogous art applicable to non-analogous kinds of data.

Thus, the combination of Holmes and Claassen is improper hindsight combination. The Office Action begins with the template of the claims and tries to reconstruct the invention within that template. To protect against such invalid and inappropriate hindsight reconstruction, the Federal Circuit has ruled that references cannot be selected,

and selected elements from selected references cannot be combined, without some suggestion, motivation, or teaching that would render obvious that selection and that combination. *See, e.g., Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."); and *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'").

Accordingly, the Office Action's combination of references is impermissible hindsight reconstruction, as described in MPEP 2145. To establish a *prima facie* case in any 35 U.S.C. 103 rejection, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. *See, e.g., In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) and MPEP 2144.08. The Office Action did not provide proper motivation to combine the references, and accordingly failed to provide a *prima facie* case for obviousness. As MPEP Section 2143.01 indicates, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Accordingly, it is respectfully requested that this rejection be withdrawn.

The Office Action did not answer the arguments previously presented regarding motivation to combine the references. MPEP 707.07(f) sets forth the Examiner's obligation to answer all material traversed. Specifically MPEP 707.07(f) states that "the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." It is essential that the Office Action address each of the arguments presented by Applicant, so that meaningful appellate review is possible. The Office Action, however, does not address Applicant's arguments. Accordingly, if the rejection is again maintained, a response to the arguments is respectfully requested in a new Non-Final Office Action.

Claims 5-13 and 25-29 were again rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes and Claassen in view of U.S. Patent No. 6,535,925 of Svanbro et al. ("Svanbro"). The Office Action took the position that Holmes and Claassen teach most of the elements of the claims, except for some elements related to encoding the information. The Office Action cited Svanbro to remedy the deficiencies of Holmes and Claassen. Applicants respectfully traverse this rejection.

Claims 5-13 and 25-29 depend from claims 1 and 19 respectively, and recite additional limitations. The impossibility of Holmes and Claassen disclosing the combination of recitations in the claims is explained above. Svanbro aggravates the deficiencies of Holmes and Claassen, because it does not provide teaching, motivation, or suggestion to make the combination of Holmes and Claassen, or the further combination including its own teachings with those of Holmes and Claassen.

Svanbro relates to packet header compression using division remainders. Specifically, in columns 5-8, Svanbro describes a header compression (Figure 3), time stamp compression (Figure 4), time stamp decompression (Figures 5 and 7), and header decompression (Figure 6). Svanbro recommends using convention header compression techniques augmented by separately compressing the time stamp. With regard to the time stamp compression, Svanbro teaches that advance knowledge obtained by empirical observation can be used to reduce the number of bits needed to encode a relatively predictable time stamp in an application such as a real-time speech service.

There is no motivation to combine Svanbro with Claassen for essentially the same reasons there is no motivation to combine Holmes with Claassen. Svanbro and Claassen are aimed at compressing radically different kinds of information. Thus, one of ordinary skill interested in compressing images might look to Claassen, but would not look to Svanbro. Similarly, one of ordinary skill interested in compressing header data might look to Svanbro, but would not look to Claassen. Therefore, the combination of Svanbro and Claassen is an improper combination, and, as explained above, the result of improper hindsight reconstruction.

Again, with regard to this rejection, the Office Action did not answer the arguments Applicants previously presented. Accordingly, if the rejection is maintained, it is respectfully requested that it be presented in a Non-Final rejection to permit Applicants to rebut the responses by argument or amendment

For the reasons explained above, it is respectfully submitted that each of claims 1-19, 21-40, and 42-52 recites subject matter that is neither disclosed nor suggested in the cited references, and the attempted combination of cited references is improper. It is therefore respectfully requested that all of claims 1-19, 21-40, and 42-50 be allowed, and that this application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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